

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed September 30, 2004. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown (U.S. Pub No. 2002/0156895) in view of Adamson (U.S. Pat. No. 5,818,442). Applicant respectfully traverses this rejection.

As an initial matter, Applicant objects to the rejection as being clearly improper for its reliance upon the Brown application. As is indicated in the Office Action, the Brown application is the *published version of the instant application*. Therefore, Applicant's own application is being cited against Applicant's claims. Applicant notes that the Brown application does not qualify as prior art under any subsection of 35 U.S.C. § 102. For at least this reason, the rejection should be withdrawn. Applicant discusses the rejection in the following, however, relative to the Adamson reference.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, the prior art does not teach or suggest all of the limitations of Applicant's claims. Applicant discusses Applicant's claims in the following.

A. Claims 1-7

Independent claim 1 provides as follows (emphasis added):

1. A method for sharing contact information, comprising:
storing a user's contact information *in a publicly-accessible database that is accessed over a network;*
receiving identification from the user of a person that the user authorizes to access the user's contact information;
receiving a request from the authorized person to access the user's contact information; and
transmitting the user's contact information to a computing device of the authorized person from the database via the network in response to the request.

Regarding claim 1, Applicant first notes that Adamson does not teach "storing a user's contact information in a publicly-accessible database that is accessed over a

network”. Instead, Adamson, at most, teaches storing contact information in relation to a general purpose electronic conference (GPEC) application that is accessible *only* to participants of an electronic conference. Adamson, column 7, lines 10-28. Because only “conference participants” can access any of the contact information in Adamson’s “database”, the database clearly is not publicly-accessible.

Applicant further notes that, contrary to that alleged in the Office Action, Adamson does not teach “receiving identification from the user of a person that the user authorizes to access the user’s contact information”. First, the Adamson system receives no identifications whatsoever from the user. Furthermore, the user is provided with no way to limit access to his contact. Instead, every participant of the electronic conference is free to access all of the contact information that is provided on the user’s electronic business card. Accordingly, the user has no control over which conference participants can access the user’s contact information.

B. Claim 14

Independent claim 14 provides as follows (emphasis added):

14. A method for sharing contact information, comprising:
storing a user’s contact information in a web server accessible
via the Internet;

*receiving from the user an identification of one or more
persons that the user authorizes to access the user’s contact
information;*

*receiving identification of what pieces of contact information
to share with each authorized person;*

receiving a request from a person to view the user’s contact
information;

verifying authorization of the person to view the user's contact information and the level of access for which the person is approved; and

transmitting to the person only the pieces of contact information that the person is authorized to view.

Regarding claim 14, Adamson does not teach “receiving from the user an identification of one or more persons that the user authorizes to access the user's contact information” for at least the same reasons that Adamson does not teach “receiving identification from the user of a person that the user authorizes to access the user's contact information” (see discussion of claim 1).

Moreover, Adamson does not teach “receiving identification of what pieces of contact information to share with each authorized person”, “verifying authorization of the person to view the user's contact information and the level of access for which the person is approved”, or “transmitting to the person only the pieces of contact information that the person is authorized to view”. Indeed, *nowhere* in the Adamson disclosure does Adamson discuss limiting the access of the conference participants to particular pieces of the user's contact information.

C. Claims 15-17

Independent claim 15 provides as follows (emphasis added):

15. A system for sharing contact information, comprising:
means for storing a user's contact information in a location that is publicly-accessible over a network;
means for receiving an identification of one or more persons that a user authorizes to access the user's contact information;

means for receiving requests from persons to access the user's contact information; and

means for transmitting the user's contact information to computing devices of authorized persons from the database in response to the requests.

Regarding claim 15, Adamson does not teach "means for storing a user's contact information in a location that is publicly-accessible over a network" or "means for receiving an identification of one or more persons that a user authorizes to access the user's contact information". Applicant refers to the discussion of claim 1 provided in the foregoing.

D. Conclusion

In summary, it is Applicant's position that a *prima facie* for obviousness has not been made against Applicant's claims. Therefore, it is respectfully submitted that the rejection of Applicant's claims should be withdrawn.

II. Canceled Claims

As identified above, claims 8-13 and 18-20 have been canceled from the application through this Response without prejudice, waiver, or disclaimer. Applicant reserves the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

III. New Claims

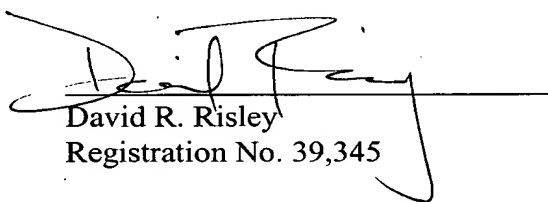
As identified above, claims 21-25 have been added into the application through this Response. Applicant respectfully submits that these new claims describe an

invention novel and unobvious in view of the prior art of record and, therefore, respectfully requests that these claims be held to be allowable.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

1-4-05
Mary Meegan
Signature